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10/627,085	07/24/2003	Christopher D. Williams	42P6485C	3138

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EXAMINER

SCHNURR, JOHN R

ART UNIT	PAPER NUMBER
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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,085	Applicant(s) WILLIAMS ET AL.	
	Examiner JOHN R. SCHNURR	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/24/2003, 11/21/2005</u> . | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

1. This Office Action is in response to Application No. 10/627,085 filed 07/24/2003.

Claims 1-33 are pending and have been examined.

2. The information disclosure statements (IDS) submitted on 07/24/2003 and 11/21/2005 were considered by the examiner.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 5-7, 9, 15, 20, 32 and 33 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-6, 11, 16 and 18 of U.S. Patent No. 7,313,806. Although the conflicting claims are not identical, they are not patentably distinct from each other because application claim 1 is generic

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to all that is recited in claim 1 of the parent. That is, application claim 1 is anticipated by claim 1 of the patent, note the following relationship.

- a. The preamble of application claim 1 and the preamble of the patented claim 1 both a method of selecting or choosing a preferences list;
- b. the claimed “receiving user identification...” step of application claim 1 corresponds to the “receiving user identification...” step of the patented claim 1;
- c. the claimed “identifying multiple preferences lists...” step of application claim 1 corresponds to the “searching a set of user-definable preferences lists...” step of the patented claim 1;
- d. the claimed “selecting one of the multiple identified preferences lists...” step of application claim 1 corresponds to the “receiving a selection...” step of the patented claim 1;
- e. the claimed “accessing...” step of application claim 1 corresponds to the “displaying...” step of the patented claim 1;

It would have been obvious to one of ordinary skill in the art to readily recognize that the patent claim 1 contains all the limitations of the application claim 1, which is broader in every aspect than the patent claim 1 and is therefore an obvious variant thereof.

Claim 5 of the application corresponds to claim 3 of the patent.

Claim 6 of the application corresponds to claim 4 of the patent.

Claim 7 of the application corresponds to claim 5 of the patent.

Claim 9 of the application corresponds to claim 4 of the patent.

Claim 15 of the application corresponds to claim 6 of the patent.

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Claim 20 of the application corresponds to claim 11 of the patent.

Claim 32 of the application corresponds to claim 16 of the patent.

Claim 33 of the application corresponds to claim 18 of the patent.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 15-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 15-19 are drawn to functional descriptive material recorded on a machine readable-medium. Normally, the claim would be statutory. However, the specification (page 20 lines 8-19) defines the claimed machine readable medium as encompassing statutory media such as a diskette, CD-ROM, magnetic tape, DVD, laser disk, ROM and Flash memory, as well as non-statutory subject matter such as receiving instructions “via network/communication interface 724”.

A signal embodying functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory classes of § 101. Rather, a signal is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims **1-4, 6, 10-18, 20-25 and 30-32** are rejected under 35 U.S.C. 102(e) as being anticipated by **Ellis et al. (US Patent 7,185,355)**, herein Ellis.

Consider **claim 1**, Ellis clearly teaches a method of choosing a preferences list comprising:

receiving a user identification for a current user; **(Fig. 10: The user selects a profile to make active, column 9 lines 51-54.)**

identifying multiple preferences lists corresponding to the current user by searching a set of preferences lists, at least some of the preferences lists of the set of preferences lists corresponding to specific users, each of the preferences lists containing multiple entertainment programming channel identifiers; **(Fig. 18: The system displays lists 182, which correspond to the active users profile, column 12 lines 15-31.)**

selecting one of the multiple identified preferences lists by receiving a user choice of one of the multiple identified preferences lists; **(The user selects one of the lists 182, column 12 lines 32-39.)**

accessing the chosen preferences list. **(Fig. 19: The chosen list is displayed to the user, column 12 lines 32-39.)**

Consider **claim 2**, Ellis clearly teaches receiving a category identification from the current user; wherein identifying comprises searching the set of preferences lists also for the identified category; and wherein selecting one of the identified preferences lists includes the identified preferences lists for the identified category. **(Fig. 18: The displayed lists 182 correspond to categories and the user selects a category, column 12 lines 15-39.)**

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Consider **claim 3**, Ellis clearly teaches identifying comprises searching the set of preferences lists also for generic preferences lists not corresponding to a specific user, and wherein selecting one of the identified preferences lists includes the identified generic preferences lists. **(If the user turns off the favorites always-on display mode the preferences lists displayed will correspond to the master profile, column 12 lines 4-8 and column 15 lines 4-7.)**

Consider **claim 4**, Ellis clearly teaches the preferences lists each correspond to at least one of a user and a category. **(Fig. 18: The lists correspond to the user and a category, column 12 lines 15-39.)**

Consider **claim 6**, Ellis clearly teaches receiving a new channel request; and determining a channel from the chosen preferences list to provide in response to the new channel request. **(When the user changes the channel the next channel in the preferences list is tuned, column 12 lines 40-62.)**

Consider **claim 10**, Ellis clearly teaches receiving an update request from a user; and updating the chosen preferences list in accordance with a received user input. **(The user may update the profile, column 10 lines 18-54.)**

Consider **claim 11**, Ellis clearly teaches the update request includes an indication of the particular preferences list that is to be updated. **(column 10 lines 18-54)**

Consider **claim 12**, Ellis clearly teaches the indication of the particular preferences list comprises a user selection from a list display. **(column 10 lines 18-54)**

Consider **claim 13**, Ellis clearly teaches if a reorder channel listings input is received, updating comprises changing the order of the channels in the list in accordance with the reorder channel listings input. **(column 14 lines 25-32)**

Consider **claim 14**, Ellis clearly teaches verifying that the identified user is authorized to access the lists and if the user is not authorized, then not updating the preferences list. **(Fig. 28: The user can require a PIN be used to access or edit the profile, column 14 line 60 to column 15 line 3.)**

Consider **claim 15**, see claim 1.

Consider **claim 16**, see claim 2.

Consider **claim 17**, see claim 3.

Consider **claim 18**, see claim 4.

Consider **claim 20**, see claim 1.

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Consider **claim 21**, see claim 2.

Consider **claim 22**, Ellis clearly teaches the user interface further comprises a remote control device with at least one of a particular category button, channel selection keys corresponding to a particular category, and an alphanumeric input. **(Fig. 1: Remote control 50 contains channel number keys, column 5 lines 47-53, and the ability to enter alphabetical characters, column 10 lines 58-63.)**

Consider **claim 23**, see claim 3.

Consider **claim 24**, see claim 6.

Consider **claim 25**, Ellis clearly teaches a channel selection controller to maintain a record of the current channel being provided to the user; and wherein the channel selector is further to compare the current channel being provided to the chosen preferences list, and if the current channel being provided is in the chosen preferences list, then to determine that the channel in the preferences list subsequent to the current channel being provided is the next channel. **(The system knows the current channel and when a channel change is requested the next channel in the list is tuned, column 12 lines 40-62.)**

Consider **claim 30**, see claim 10.

Consider **claim 31**, see claim 14.

Consider **claim 32**, see claims 1 and 22.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims **5, 7-9, 19, 26-29 and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al. (US Patent 7,185,355)** in view of **Stinebruner (US Patent 6,133,910)**.

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Consider **claim 5**, Ellis clearly teaches choosing a preference list and accessing content via programming identifiers displayed in the list.

However, Ellis does not explicitly teach the identifiers identifying particular communication paths for entertainment programming from any one of a wide variety of different transport media.

In an analogous art, Stinebruner, which discloses a system for receiving and displaying video content, clearly teaches identifiers identifying particular communication paths for entertainment programming from any one of a wide variety of different transport media. **(Fig. 1: Video signals are received via a plurality of sources 5, column 4 line 63 to column 5 line 18. Fig. 2: Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15.)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Ellis by identifying particular communication paths for entertainment programming from any one of a wide variety of different transport media, as taught by Stinebruner, for the benefit of simplifying the tuning process when video content is received from multiple sources (see column 2 lines 26-39 Stinebruner).

Consider **claim 7**, Ellis combined with Stinebruner, as in claim 5, clearly teaches tuning a component of an entertainment system to the determined channel once the next channel is determined **(When the user changes the channel the next channel in the preferences list is tuned, column 12 lines 40-62 Ellis.)** by sending a message to a component controller indicating an appropriate device within the entertainment system that is a source for the determined channel, as well as an identifier of the determined channel. **(column 5 line 56 to column 6 line 14 Stinebruner)**

Consider **claim 8**, Ellis combined with Stinebruner, as in claim 5, clearly teaches the chosen preferences list includes information that identifies a component within the entertainment system to tune to the determined channel. **(Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15 Stinebruner.)**

Consider **claim 9**, Ellis combined with Stinebruner, as in claim 5, clearly teaches accessing an electronic programming guide (EPG) database to identify a component for tuning to the determined channel. **(Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15 Stinebruner.)**

Consider **claim 19**, see claim 8.

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Consider **claim 26**, see claim 7.

Consider **claim 27**, see claim 7.

Consider **claim 28**, see claim 8.

Consider **claim 29**, see claim 9.

Consider **claim 33**, see claim 9.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN R. SCHNURR whose telephone number is (571)270-1458. The examiner can normally be reached on Monday - Friday, 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JRS

/Christopher Grant/

Supervisory Patent Examiner, Art Unit 2623